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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,349	11/14/2003	Tomotaka Yagi	2003_1642	1173

513 7590 09/27/2004

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EXAMINER	
NGUYEN, HUY THANH	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/712,349	YAGI ET AL.	
	Examiner	Art Unit	
	HUY T NGUYEN	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/210,948.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/04/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, line 3, there is no antecedent basis for "the optical disc".

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 4 –6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 4-6 direct to information resided on a medium. Since the information does not provide any functional relationship to the medium accessing the information or controlling the medium, or impart to any software and hardware structural components to provide certain function that is processed by a computer, the information do not make them statutory. See MPEP 2100.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,282,363. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-3 and claims 1-2 is that claims 1 of U.S. Patent No. 6,282,363 additionally recite that the identifying of the second stream is achieved through the buffer that is not found in claim 1 of the present application . However, it is noted that omitting a part and its function is obvious to one of ordinary skill in the art . Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963).Therefore, it would have been obvious to one of ordinary skill in the art to modify 1 of U.S. Patent No. 6,282,363 by omitting the recitation using of buffer as means for identifying the second stream and to produce claim 1 of the present application . Further for 2 and 3 of the present application, see claims 1-2 of U.S. Patent No. 6,282,363.

6. Claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6 of U.S. Patent No. 6,393,206. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the difference between claims 4-6 of the present application and claims 4-6 of U.S. Patent No. 6,393,206 is that claims 4-6 of U.S. Patent No. 6,393,206 called for a method of recording video and audio stream of video objects on a optical disc and claims 4-6 of the present application called for a medium for storing the video and audio streams of video objects on a medium . However, it would obvious to one of ordinary skill the art to recognize that the method claims 4-6 of U.S. Patent No. 6,393,206 can be used for storing the same information on a medium and to produce claims 4-6 of the present application since an optical disc can be considered as medium .

7. Claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. 6,404,980. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 4-6 of the present application and claims 5-7 of U.S. Patent No. 6,404,980 is that claims 5-7 of U.S. Patent No. 6,404,980 called for a method of recording video and audio stream of video objects on an optical disc and claims 4-6 of the present application called for a medium for storing the video and audio streams of video objects on a medium . However, it would obvious to one of ordinary skill the art to recognize that the method claims 5-7 of U.S. Patent No. 6,404,980 can be used for storing the same information on a medium to produce claims 4-6 of the present application since an optical disc can be considered as medium.

8. Claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,678,466. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 4-6 of the present application and claims 1-3 of U.S. Patent No. 6,678,466 is that claims 1-3 of U.S. Patent No. 6,678,466 called for an optical for storing recording video and audio stream of video objects on a optical disc and claims 4-6 of the present application called for a medium for storing the video and audio streams of video objects on a medium . However, it would obvious to one of ordinary skill the art to recognize that the method claims 1-3 of U.S. Patent No. 6,678,466 can be used for storing the same information on a medium to produce claims 4-6 of the present application since an optical disc can be considered as medium.

9. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,456,780. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 4 of the present application and claim 13 of U.S. Patent No. 6,456,780 is that claims 13 of U.S. Patent No. 6,456,780 additionally recite management information on a optical disc that is not found in claim 4 of the present application. However, it is noted that omitting a part and its function is obvious to one of ordinary skill in the art. See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to omitting the recitation of management

information from claim 13 of U.S. Patent No. 6,456,780 to produce claim 4 of the present application .

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor ,acting, Thai Tran can be reached on (703) 305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PRIMARY EXAMINER